

Appl. No. : **10/790,932**
Filed : **March 2, 2004**

AMENDMENTS TO THE DRAWINGS

Figure 3 has been amended to eliminate element 82 and the lead line point to the bottom surface of the seat. A replacement sheet (entitled "Replacement Sheet") is enclosed with this response.

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REMARKS

Please reconsider the above-identified application in view of the amendments set forth above and in view of the remarks set forth below.

Drawing and Specification Amendments Address Drawing and Specification Objections

The drawings and specification have been objected to for three reasons. First, the reference numeral 82 has been used in Figure 3 to identify two different elements. Second, the reference numeral 263 does not appear in the figures. Third, the reference numeral 262 has been used to designate two different elements.

Applicant has amended Figure 3 to remove the reference numeral and line pointing to a lower surface of the seat. This amendment removes the basis for the objection. Reconsideration and withdrawal of the objection are respectfully requested.

Applicant has amended paragraph [0087] to replace the reference numeral 263 with the intended reference numeral 262. This amendment removes the basis for the objection. Reconsideration and withdrawal of the objection are respectfully requested.

Applicant has amended paragraph [0086] to remove the reference numeral 262 used in connection with the front differential input shaft. This amendment removes the basis for the objection. Reconsideration and withdrawal of the objection are respectfully requested.

Claims 1-5, 13-17 and 20-23 Are Patentable Over The Applied Combination

Claims 1-5, 13-17 and 20-23 have been rejected as unpatentable over Leipert (U.S. Patent No. 1,852,464) in view of Fukamachi et al. (U.S. Patent No. 6,405,823).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In*

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re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.* (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

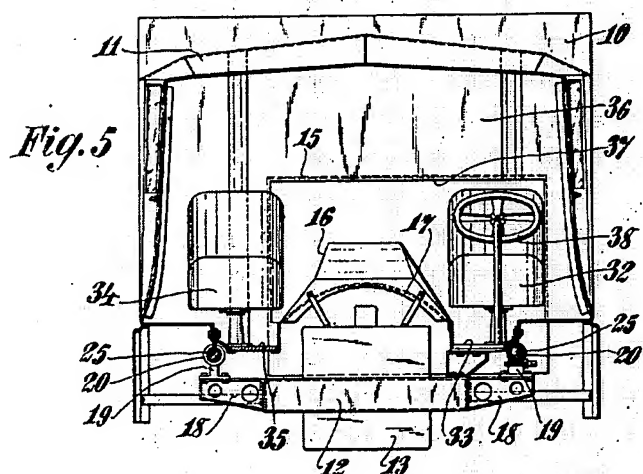
Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *See Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *See WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. *See Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." *Id.*

In the present case, the motivation could not have come explicitly from statements in the prior art. The motivation also could not have been based upon the problem to be solved because the applied prior art did not recognize the existence of the problem being solved. Furthermore,

the motivation could not have been implicit from the prior art as a whole because the references were directed to fundamentally different forms of motor vehicles than that claimed.

Leipert (United States Patent No. 1,852,464) taught a cab construction in which an engine 13 and the associated controls were entirely enclosed by the cab 11. See lines 4-9. The



cab construction taught by Leipert provided free accessibility to the engine 13 and all of the related controlling mechanisms. See lines 27-31. In particular, the cab 11 was moveable in such a fashion as to expose completely the engine 13 and the controlling elements in order that they may be conveniently installed and serviced. See lines 12-16.

The cab 11 contained a driver's seat 32 and an attendant's seat 34. The driver's seat 32 was mounted on a stationary floor 33 carried by the chassis while the attendant's seat 34 was mounted on a movable floor 35 of the cab 11.

Fukamachi et al. taught an all terrain vehicle, which is significantly different in construction than the truck taught by Leipert. An image that combines the images of Figure 1 and Figure 2 of Fukamachi is shown below. As shown, the engine of Fukamachi was an internal combustion engine.

The engine received an air/fuel mixture through an air intake system. The air intake system featured a carburetor 20 (shown almost directly vertically below a rear portion of the seat) and an

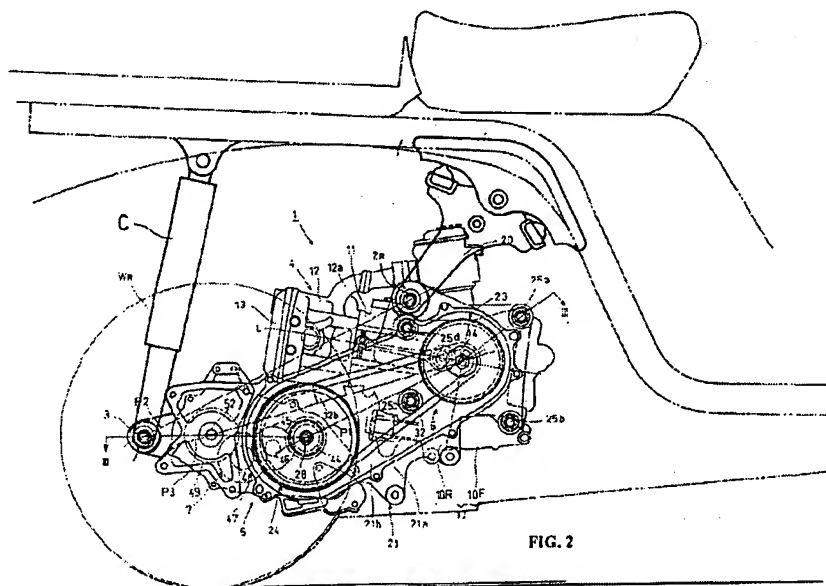


FIG. 2

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intake port 12a. An intake passage extended between the intake port 12a and the carburetor. The engine of Fukamachi was designed to pivot relative to the frame because it was directly connected to the rear wheels. Thus, the wheels and the engine were connected to the shock absorber C.

The Examiner has explained that the motivation to place the Fukamachi engine within the Leipert truck cab would be to "have the advantage of being able to swing the engine vertically in order to undertake major repairs while seated in the vehicle." *Page 4 of Office Action Mailed October 20, 2004*. Applicant submits that the Examiner's reasoning flies in the face of the express teachings of the prior art. Leipert was specifically addressing serviceability concerns. In response to serviceability concerns, as discussed above, Leipert constructed a vehicle in which the truck cab would slide forward relative to the engine and the related components such that the entire engine and the related components would be exposed and serviceability would be improved. Fukamachi, to the contrary, did not address serviceability but was directed to reducing vibrations in constructions featuring engines that pivot relative to the frame during operation of the vehicle. It is clear that the Examiner has relied upon hindsight in formulating the present rejection; there is no proper teaching or suggestion to combine the cab construction of Leipert with the engine of Fukamachi.

Furthermore, Leipert is not analogous art. As the Examiner is aware, for the purpose of analyzing the obviousness of claimed subject matter, the Examiner must determine what analogous art is. "In order to rely on a reference as a basis of rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). *See also In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotta America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside

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the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). While the Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of “nonanalogy” or “analogy” respectively, the courts have found that the similarities and differences in structure and function of the inventions carry far greater weight. *See In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) and *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

In this case, the present invention relates to air intake systems for off-road vehicles. As explained in the Summary of the Invention, the air intake systems of off-road vehicles require more protection than the air intake systems of other vehicles. *See [0008]*. Leipert, however, was directed to a movable cab for large motor vehicles. Specifically, Leipert was directed to “an improved cab construction for motor vehicles of the commercial type.” *See Lines 1-4 of United States Patent No. 1,852,464*. To the extent that classification is relevant, Leipert was classified in 180/089.16 (Motor Vehicles: Bodies; Movable Cab or Operator’s station; Overmotor Cab) and 180/068.4 (Motor Vehicles: Power; Radiators and condensers, mounting), neither of which has anything to do with protecting an air intake system of an off-road vehicle.

Not all motor vehicles are designed with the same concerns in mind. Protecting the air intake system of a commercial type vehicle is not a concern during vehicle design in the way that it is in the design of off-road vehicles. In addition, a person seeking to protect an air intake system of a small, off-road vehicle would not look to the design of commercial type vehicles that are designed for over-the-road operation for inspiration. Moreover, the commercial type vehicle of Leipert and the off-road vehicle of the present application have wildly different structures due, at least in part, to the differences in intended use of the vehicles. For these reasons, Leipert is not a proper reference upon which an obviousness rejection may be based.

Moreover, even if both of the references were analogous and were properly combinable, many of the rejected claims recite further limitations that are not taught by the combination. For example, Claim 2 recites that the engine has a front surface that generally faces the space with the intake port opening at the front surface. By way of another example, Claim 16 recites an exhaust port communicating with the combustion chamber with the exhaust portion opening

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through a rear surface of the engine. Other examples also can be found throughout the rejected claims. Such configurations were not taught or suggested by the applied combination.

Leipert is not a reference that can be used for an obviousness rejection. Even if Leipert were a proper reference, there is no proper suggestion or motivation to combine the references in the manner set forth in the Office Action. Moreover, even if the references were properly combined, the claims define over the applied combination. Accordingly, the Examiner has not set forth a *prima facie* case of obviousness. Reconsideration and allowance of Claims 1-5, 13-17 and 20-23 are respectfully requested.

Claims 6-12 Are Patentable Over The Applied Combination

Claims 6-12 have been rejected as unpatentable over Leipert in view of Fukamachi et al. and further in view of Rioux et al. (U.S. Patent No. 6,648,093). Claims 6-12 depend from Claim 1. Adding Rioux et al. to the rejection set forth above does not resolve the deficiencies in the rejection of Claim 1 that were set forth above. Thus, Claims 6-12 are patentable for at least the same reasons as Claim 1 is patentable. Applicant disagrees with the basis for the rejection but need not further address the rejection of Claims 6-12 in view of the deficiencies in the rejection of the independent claims. Reconsideration and allowance of Claims 6-12 are respectfully requested.

Claims 18 and 19 Are Patentable Over The Applied Combination

Claims 18 and 19 have been rejected as unpatentable over Leipert in view of Fukamachi et al. and further in view of Matsuura et al. (U.S. Patent No. 6,920,949). As an initial matter, U.S. Patent No. 6,920,949 is only prior art under 102(e) and, therefore, is subject to disqualification under 103(c). Nevertheless, even if the '949 were proper prior art, the underlying rejection of Claim 1 is flawed in manners that the Matsuura et al. does not address. Thus, Claims 18 and 19 are patentable for at least the same reasons as Claim 1 is patentable. Applicant need not further address the rejection of Claims 18 and 19 in view of the deficiencies in the rejection of the independent Claim 1. Reconsideration and allowance of Claims 18 and 19 are respectfully requested.

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New Claims 24-27 Have Been Added

Claims 24-27 have been added to recite additional patentable aspects of the present invention. For instance, Claims 24 and 26 recite that the seat assemblies are fixed to the frame. This is different from the sliding configuration of at least one of the seat assemblies of Leipert. Claims 25 and 27 recite that the engine comprises a cylinder block that is positioned over a transmission housing and that the air intake system generally is positioned forward of the cylinder block and over a portion of the transmission housing. This is discussed at [0097] to protect the air intake system from the heat generated by the engine. Consideration and allowance of these claims also are respectfully requested.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections and objections set forth in the outstanding Office Action are inapplicable to the present claims, drawings and specification. Accordingly, issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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